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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------------|------------------------|
| 10/654,301 | 09/03/2003 | Steven J. Ross | GP-303673/GP-303674 (2760) | 4415 |
| 286 7590 08/03/2009 GENERAL MOTORS COMPANY LEGAL STAFF MAIL CODE 482-C23-B21 P O BOX 300 DETROIT, MI 48265-3000 | | | EXAMINER NGUYEN, CUONG H | |
| | | | ART UNIT 3661 | PAPER NUMBER |
| | | | MAIL DATE 08/03/2009 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/654,301 | Applicant(s) ROSS ET AL. | |
| | Examiner CUONG H. NGUYEN | Art Unit 3661 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-15 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,11,21 and 25 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26 is/are allowed.
- 6) ☒ Claim(s) 3,5,8-10,12-15,18-20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. This is the answer to a communication filed on 3/17/2009.
2. Claims 1-5, 8-15, and 18-26 are pending; previous restrictions are made final since different claimed embodiments as shown (see Office Actions mailed on 9/09/08 and 3/17/09) cause more burdens to examine different invention's scopes - i.e., applying different fields and strategies for searches to these BROAD pending claims).
3. On 4/17/2009 Applicants provisionally elected, with traverse, claims 3, 5, 8-10, 12-15, 18-20, and 22-24 for examinations.

Response

4. For a proper format, Applicants should indicate a current status of each pending claim following claim's number – in a submitted claimed listing of 3/17/2009:

Pending “method” claim 3 merely requires limitations of exchange/”shaking hand” between 2 remote components before communications – these limitations are very fundamental for electronic/computer communications (e.g., steps of communications between *a computer server to a remote laptop computer* - not necessary for vehicle - or in the field of automobiles - claimed steps – as shown - obviously apply to all remote devices/facilities).

Applicants BROADLY claim about a concept of electronically/wireless communication between 2 parties – this subject has been very well-known in computer communications (e.g., communications between a laptop and a computer server for downloading updated data); obviously, this kind of communication is not for ONLY vehicle's applications.

Claim 3 is interpreted as followed: it BROADLY requires 3 steps:
- sending a “flag” signal from (A) to (B) before/prior to a real “action” (e.g., sending a phone ring before talking) – this is a third step in pending claim 3;

- receiving a “certain” signal (e.g., an update signal) at (A) from (B);
- sending “computer” settings from (A) to (B) responsive to the update signal.

These claimed steps are very well-known in electronic communications because these signals are fundamental before transmit/receive signals – note that it is not necessary for a “vehicle”, and “telematics unit” is merely a remote unit that can be sent thru. Wire (not necessary “wireless”).

Claim Rejections - 35 USC 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 12-15, and 18-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for providing vehicle settings for a telematics unit in a mobile vehicle, does *not reasonably provide enablement* for a computer-readable medium with claimed “computer-readable codes” (i.e., where are these claimed software codes?). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

A. As to claim 12: It clearly requires a limitation of:

- *computer readable code for implementing the vehicle settings ...* (see claim 12, line 3).

B. As to claim 13: It clearly requires limitations of:

- *computer readable code for processing a received vehicle settings update signal from the telematics unit;*

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- computer readable code for sending vehicle settings from a call center to the telematics unit responsive to the update signal; and

- computer readable code for sending an update flag signal prior to the call center receiving the vehicle settings update signal.

C. As to claim 14: It clearly requires a limitation of:

- computer readable code for processing at least one received user preference ... (see claim 14, line 3).

D. As to claim 15: It clearly requires limitations of:

- computer readable code for processing a received vehicle settings update signal from the telematics unit;

- computer readable code for sending vehicle settings from a call center to the telematics unit responsive to the update signal;

- computer readable code for processing at least one received user preference at the call center via a web portal interface prior to the call center receiving the vehicle settings update signal; and

- computer readable code for sending an update flag signal from the call center to the telematics unit responsive to receiving the at least one user preference at the call center via the web portal interface.

E. As to claim 18: It clearly requires limitations of:

- computer readable code for processing a received vehicle settings update signal from the telematics unit;

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- *computer readable code for transmitting at least one download requirement to the telematics unit;*
- *computer readable code for processing a received download reply from the telematics unit responsive to the at least one download requirement;*
- *computer readable code for determining a download status of the telematics and associated components unit based on the received download reply;*
- *computer readable code for storing the vehicle settings when the download status of the telematics unit and associated components is negative; and*
- *computer readable code for transmitting the vehicle settings from the call center to the telematics unit when the download status of the telematics unit and associated components is positive.*

F. As to claim 19: It inherits deficiencies from claim 18; therefore, it is also rejected on 35 USC 112, 1st para.

G. As to claim 20: It clearly requires limitations of:

- *computer readable code for determining a store status for the vehicle settings when the download status of the telematics unit and associated components is negative;*
- *computer readable code for storing the vehicle settings when the store status is positive; and*
- *computer readable code for deleting the vehicle settings when the store status is negative.*

The examiner fails to locate in the submitted disclosure what the applicants claim as their limitations: i.e., “computer-readable codes for ...” (i.e., where are these claimed software codes?); therefore, section 35 USC 112, 1st para. (as defined above) is not conformed due to a lack of disclosure of what they claim for enablement.

Claim Rejections - 35 USC §101

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 22-24 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter although they recite “system” claims.

Claims 22-24 are rejected as being "software per se". These claims are directed towards a "SYSTEM" comprising “means-plus-function” components. However, it is noted that the use of the word "system" does not inherently mean that these claims are directed towards a machine or an article of manufacture since there is no explicitly mention of physical hardware elements such as a processor and memory. The claimed invention is also addressed towards different modules, all of which can be interpreted as comprising entirely of software per se according to one of ordinary skill in the art. Therefore, the claim language fails to provide the necessary hardware required for these claims to fall within the statutory category of a machine or an article of manufacture (see MPEP 2106). Accordingly, the claim becomes nothing more than sets of software instructions which are "software per se".

"Software per se" is non-statutory under 35 USC 101 because it is merely a set instruction without any defined tangible output or tangible result being produced. The requirement for tangible result under 35 USC 101 is defined in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47USPQ2d 1596 (Fed. Cir. 1998).

- The applicants can overcome this rejection by explicitly mention in these claims that the system comprises physical hardware such as a processor and memory.

A. As to claim 22: This claim comprises a limitation of “means for determining a download status of the telematics unit...” (see claim 22, line 9), this limitation is – essentially - computer-executable codes – as claimed (see also claims 13, and 15 – note that claims 22-24, 13, and 15 must be geared toward a common unique concept: using computer-readable codes) - (these are merely functional descriptive material - e.g. data structures or software, *per se*; section 35 USC 101 requires a physical medium to store these codes; therefore, they rejected on 35 USC 101 because they are not conformed to this section.

- A claim to software, program, instructions, code or an appropriate data structure not clearly on any medium e.g., " a program comprising code for...", or “computer readable codes for ...;”
- A "system" or apparatus defined merely by software or terms synonymous with software or files such as "modules", "engine", "webpage", "tool", "logic", "interface", "means for determining ...", etc.

B. Claims 23-24 are also rejected on 35 USC 101 because they inherit that deficiency from a based claim 22.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international

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application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

7. Claims 3, and 13 are rejected under 35 U.S.C. § 102(e) as being anticipate by Matula et al., (US Pub. 2003/0181162 A1).

Claim 3 is reasonably interpreted as followed: it requires 3 steps,

- sending a “flag” signal from (A) to (B) before/prior to a real “action” (for a familiar act of “shaking-hands”;
- receiving a signal (e.g., an update signal) at (A) from (B);
- sending settings from (A) to (B) responsive to the update signal.

Those 3 required steps are inherently/explicitly taught by Matula (see Fig. 1, electronic communications are exchanged between “B” (a telematic unit 14 in a vehicle 15), and a ground facility/a call center 16 as “A”).

8. Claims 5, and 14-15, 18 are rejected under 35 U.S.C. § 102(e) as being anticipate by Rigo et al., (US Pub. 2002/0049535 A1).

Rigo et al. teach claimed steps of:

- receiving an update signal (see Rigo et al., para. [0048], [0051]) at “A” (a central station/a call center) from “B” (a telematics unit/vehicle 10), (see Rigo et al., Fig.1 shows a relationship between “A” and “B”, para. [0026]);
- sending signals/settings from “A” (a central station/a call center) to “B” (a telematics

unit/vehicle 10), (see Rigo et al., Fig.1) responsive to a signal;

- receiving a preference (i.e., receiving a specific information/data, see Rigo et al., para. [0027]) at “A” (a central station/a call center) via a web portal interface (see Rigo et al., Fig.1 ref. 20, para. [0048], [0051]) prior to “A” (a central station/a call center) receiving an update signal (see Rigo et al., Fig.1, para.[0027]); and
- sending a flag signal from “A” (a central station/a call center) to “B” (a telematics unit/vehicle 10), responsive to “a preference” signal at “A” (a central station/a call center) via the web portal interface (see Rigo et al, Fig.1 ref. 20, para. [0027]), and prior to “A” (a central station/a call center) receiving the update signal (this feature is inherent in Rigo et al., because prior to communicate/talk, both parties/sides must “shake-hand” first by exchanging signals).

Rigo et al. teach claimed steps via a communication relationship between “A” and “B” in a read-on claimed environment (see Rigo et al., Fig.1).

As to claim 18: Rigo et al. clearly “process” above signals using a computer (see Rigo et al., Fig. 3, ref. 42).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8-10, 12-15, 18-20, and 22-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rigo et al., (US Pub. 2002/0049535 A1), in view of Duperrouzel et al., (US Pat. 7,149,982).

A. As per claims 8, 18, and 22: Rigo teaches a method comprising steps:

- receiving a vehicle settings update/edit signal at a call center from a telematics unit (see Rigo et al., para. [0052], [0028]);
- transmitting a requirement to the telematics unit (e.g., checking for a compatible condition);
- receiving a reply from the telematics unit responsive to that download requirement (see Rigo et al., para. [0044], [0054], [0026], and [0028]).

Rigo et al. do not disclose that “determining a download status of the telematics unit and associated components based on the received download reply; storing the vehicle settings when the download status of the telematics unit and associated components is negative; and transmitting the vehicle settings from the call center to the telematics unit when the download status of the telematics units and associated components is positive.”

However, Duperrouzel et al., suggest that idea of determining a download status (via a use of a download status indicator 248, as in: “*A status indicator 248 indicates whether the user terminal 110 is currently in a process of downloading a web page for display one of the display panes 212a-212d. Downloading is indicated by a flashing symbol (not shown) in the status indicator 248, and each of the status indicators 248 of the display panes 212a-212d show numerals 1-4, respectively, when downloading is completed. The numerals 1-4 respectively designate a "pane number" for the display panes of the telematics unit and associated components based on the received download reply*”, (see Duperrouzel et al., col. 7 lines 1-7 – note that Duperrouzel et al.’s unit is in “stationery” (not moving while downloading);

It has been well-known in computer field that in order for downloading, settings must be in agreement on both sides; therefore, claiming that if downloading status is still negative (not completing this step yet) those settings must be stored proving a receiver side is ready for downloadings; and for transmitting the vehicle settings from the call center to the telematics unit (see Rigo et al., para. [0043}, [0028]) when the download status of the telematics units and associated components is positive: it has been obvious to one with ordinary skill in the art to combine Rigo et al., and Duperrouzel et al. for downloading conditions because these claimed limitations have been well-known before this invention is made for the advantage of knowing communication steps (these computer's data-transferring steps are similar for a laptop computer in a vehicle).

B. As per claims 9, 12, 19, and 23: Duperrouzel et al., teach these claims' limitation of: a remote/telematics unit determines associated component statuses are in a modifiable/edit (e.g., for storing) state (see Duperrouzel et al., col. 13 line 60 to col. 14 line 6; and claim 21).

C. As per claims 10, 20, and 24: Duperrouzel et al., also teach these claims' limitations of storing settings/configurations:

- determining a store status for settings (see Duperrouzel et al., col. 10 lines 63-67, "*As previously described above with respect to saving the locations of the vertical scroll bars 262 and horizontal scroll bars 256, the "on" and "off" HTML settings for the toolbars and status bars can be saved for automatic recall or execution during future communications with the network 130.*")

when the download status of the telematics unit and associated components is negative;

- storing the vehicle settings when the store status is positive; and

deleting the vehicle settings when the store status is negative (see also Duperrouzel et al., claims 1, 13, and claim 22).

Duperrouzel et al., do not need to spell-out “determining a store status for ... when the download status of the telematics unit and associated components is negative” (e.g., determining a storage capacity of a laptop before downloading software); and “storing the ... settings when the store status is positive” (e.g., if a capacity of a laptop’s storage device is O.K., then perform a download step); and “deleting the vehicle settings when the store status is negative” (e.g., if a laptop’s storage device is NOT capable to store, not downloading, and delete that settings) because those claimed reasons have been very logical and fundamental.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement Rigo et al.’s invention with Duperrouzel et al.’s idea because this kind of computer-to-computer’s communication is similar to steps of providing vehicle settings – e.g., a remote object - from a server to a telematics unit in a mobile vehicle.

Allowable Claim

10. Claim 26 is allowable.

Conclusion

11. Pending claims 1-5, 8-15, and 18-25 are rejected. Claim 26 is allowed.

12. Remark: Pending claims 22-24 are directed to a system containing physical components, and pending claims 12-15, and 18-20 are for an article of manufacturer; therefore, those physical components/computer-readable codes make up a structure as required limitation(s) in these pending claims (see ex parte Masham, 2 USPQ2d 1647 (Bd Pat. App. & Inter. 1987).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759 (email address: cuong.nguyen@uspto.gov). The examiner can normally be reached on 8:30 am -

4:30 pm (Mon. – Tues., and Thurs. – Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

/CUONG H. NGUYEN/
Primary Examiner
Art Unit 3661